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10/697,189	10/30/2003	Gary Hochman	0813-016P/JAB	8180

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SCHWEITZER CORNMAN GROSS & BONDELL LLP
292 Madison Avenue
New York, NY 10017

EXAMINER	
OMOTOSHO, EMMANUEL	
ART UNIT	PAPER NUMBER
3714	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/697,189	HOCHMAN, GARY	
	Examiner	Art Unit	
	Emmanuel Omotosho	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/23/06*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 5-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. In response to the amendment filed on 8/23/2006, the changes to the drawing and claims 1-3 have been entered; and claims 1-3 and 5-18 are pending.

Information Disclosure Statement

2. The applicant's field of endeavor, "Interactive Educational System", contains numerous prior arts pertinent to what is currently being claimed. The examiner is uncertain as to why there is no IDS entry from the applicant. In addition to the next response, the applicant is highly encouraged to put on record pertinent references.

Drawings

3. The proposed drawings still hold a high level of unclearness. For example, the different successive dots in the application currently has no meaning and its unclear to what they signify. The examiner is unsure as to what the different arrows and lines are representing. The examiner is finding it extremely hard to decipher what the squiggly line between the internet label and box labeled 30 is for. If the different arrows are representing 'a flow', where does the flow start? Thus, simply circling the numbers on the drawing as an attempt to clarify does not clarify anything, after all, the encircling of reference numbers is prohibited by 37 CFR 1.84(p). Applicant should submit a similar revision that clarifies the drawing as a whole to further aid in the proper disclosure and

explanation of the claimed invention. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because it is very difficult to understand the written labels. These labels should be either neatly handwritten or typed such that they can be easily deciphered. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 10, 12, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrow et al. (US Patent No. 6,178,308) in view of Poor (US Patent No. 5,672,060).

Regarding claim 1, Bobrow discloses the steps of:

a) disseminating gradable material to at least one student for the student to enter gradable information therein (elements 201-203 in Figure 2);

b) collecting the gradable material and determining a grade therefore (Figure 10; col. 10, lines 35-37);

c) entering teacher-generated review data for the student from whom the gradable material was collected upon the gradable material in a machine readable format (items 210 and 211 in Figure 2, col. 10, lines 35-40);

d) capturing and storing an image of the gradable material, including the review data, (steps 211 and 205 in Figure 2) in an electronic folder associated with a student identification code thereon (col. 10, lines 42-44); and

e) providing controlled viewing access to the image by specified viewers (step 210 in Figure 2; item 301 in Figure 3; col. 4, lines 52-58).

Bobrow does not expressly disclose that the user to receive access to the image should be authorized. However, Poor teaches a system that captures and stores an image of gradable material, providing controlled viewing access to the image by authorized viewers in the Abstract. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the authorization process taught by Poor in the method disclosed by Bobrow in order to allow for secure access of elements stored in the system.

Bobrow, as modified by Poor, does not expressly teach that the teacher generated review data is placed directly upon the collected gradable material. More specifically, Bobrow discloses that the gradable material is first scanned into the system and printed out in an organized fashion for the teacher to grade (col. 10, lines 30-40). However, it would have been obvious to one of ordinary skill in the art at the time of invention to eliminate the step of scanning in the student exams in order to organize the

content by questions if the result is not desired (see MPEP § 2144.04). The reasoning of eliminating this step would be to save paper.

Regarding claim 10, Bobrow'308 further discloses that the gradable material can be returned to the student after it has been scanned into the system (col. 10, lines 44-50).

Regarding claim 12, Bobrow'308 discloses that the image is a scanned electronic image of the original document (col. 4, lines 7-10).

Regarding claim 14, Bobrow'308 discloses that the grade is placed upon the gradable material in a machine-readable format (col. 8, line 60; col. 10, lines 35-38).

Regarding claim 16, the system of Bobrow'308 further comprises an external storage device to which data can be stored (col. 12, lines 26-27, item 1305 in Figure 13; col. 10, lines 42-44).

5. Claims 2 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrow, as modified by Poor, further in view of Clare (2000). Bobrow, as modified by Poor, teaches a step of locating a label on the gradable material having a pre-determined data capture format for review data to be placed thereon (col. 5 lines 9-14; col. 10, lines 35-40) and placing review data upon the label (col. 5, lines 21-26). Bobrow, as modified by Poor, does not expressly teach that the label is separate from the gradable material or that it should be affixed to the gradable material. However, Clare teaches a technique by which a teacher may affix a sticker with evaluation

information thereon to gradable material submitted by the student (p. 27, #2). It would have been obvious to one of ordinary skill in the art at the time of invention to provide sticker labels for the evaluation of the students in order to allow the teacher to only place a finalized grade on the gradable material and thus prevent the teacher from making mistakes in grading directly on the gradable material.

Regarding claims 5-6, Bobrow discloses that the review data includes a grade and that the review data capture format accommodates the grade (col. 8, line 60; col. 10, lines 35-38).

Regarding claim 7, Bobrow further discloses that the label includes a specified location for the student identification code (col. 5, lines 18-20, see claim 3 rejection).

6. Claims 3, 8/3, 9, 11/3, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrow, as modified by Poor, and further in view of Kraft et al. (US Patent No. 4,978,305).

Regarding claims 3, 8/3, and 9, Bobrow, as modified by Poor, does not teach the affixation of a separate label to the gradable material. However, Kraft discloses a grading system comprising the step of locating a label on the gradable material having a specified location (i.e., on each exam) for the affixation of the student identification code (i.e., examinee number), wherein the step of locating a label comprises the affixation of a separate label to the gradable material, wherein the label includes a pre-printed student identification code (col.7, lines 30-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Kraft

of adding the step of affixing a label to the method of Bobrow, as modified by Poor, in order to allow a student to more easily label all work with their student identification code.

Regarding claim 11/3, Bobrow, as modified by Poor, does not teach that the identification code is entered on the gradable material after the gradable material is collected. However, Kraft teaches this aspect (col.7, lines 61-64). It would have been obvious to one of ordinary skill in the art to modify the method disclosed by Bobrow, as modified by Poor, in the way taught by Kraft in order to allow for the affixation of the student identification code after the assignment had been submitted, in case the student had forgotten to attach it.

Regarding claim 15, Bobrow, as modified by Poor, does not teach the step of placing a captured grade in an electronic grade book or database. However, Kraft teaches this aspect (col.10, lines 12-24). It would have been obvious to one of ordinary skill in the art at the time of invention to add the electronic grade book updating step to the method of Bobrow, as modified by Poor, in order to make it easier for the grader to keep track of the grades recorded on the assignments.

7. Claims 8/7, 11/7, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrow, as modified by Poor and Clare, further in view of Kraft.

Regarding claim 8/7, Bobrow, as modified by Poor and Clare, does not teach the affixation of a separate label to the gradable material. However, Kraft discloses a grading system comprising the step of locating a label on the gradable material having a

specified location (i.e., on each exam) for the affixation of the student identification code (i.e., examinee number), wherein the step of locating a label comprises the affixation of a separate label to the gradable material, wherein the label includes a pre-printed student identification code (col.7, lines 30-35). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Kraft of adding the step of affixing a label to the method of Bobrow, as modified by Poor and Clare, in order to allow a student to more easily label all work with their student identification code.

Regarding claim 11/7, Bobrow, as modified by Poor and Clare, does not teach that the identification code is entered on the gradable material after the gradable material is collected. However, Kraft teaches this aspect (col.7, lines 61-64). It would have been obvious to one of ordinary skill in the art to modify the method disclosed by Bobrow, as modified by Poor and Clare, in the way taught by Kraft in order to allow for the affixation of the student identification code after the assignment had been submitted, in case the student had forgotten to attach it.

Regarding claim 15, Bobrow, as modified by Poor and Clare, does not teach the step of placing a captured grade in an electronic grade book or database. However, Kraft teaches this aspect (col.10, lines 12-24). It would have been obvious to one of ordinary skill in the art at the time of invention to add the electronic grade book updating step to the method of Bobrow, as modified by Poor and Clare, in order to make it easier for the grader to keep track of the grades recorded on the assignments.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrow, as modified by Poor, further in view of Romano et al. (US 5,991,595). Bobrow, as modified by Poor, does not disclose expressly wherein the step of providing viewing access is through the Internet. However, Romano teaches this aspect (col. 6, lines 49-54). Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate providing viewing access through the Internet into the method and system of Bobrow, as modified by Poor, in light of the teaching of Romano, in order to enable a remote communication means.

9. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrow, as modified by Poor, further in view of Housman et al. (US 2003/00224340).

Regarding Claim 17, Bobrow, as modified by Poor, does not disclose expressly wherein the secondary storage media is a CD. However, Housman teaches such on p.1, [0007]. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate wherein the secondary storage media is a CD into the method and system of Bobrow, as modified by Poor, in light of the teaching of Housman, in order to provide a storage media to write files to.

Regarding claim 18, Bobrow, as modified by Housman, does not disclose expressly wherein the transferring step comprises the transfer of a plurality of stored images associated with a particular student identification number (i.e., images if materials associated with specific students). However, Poor teaches this aspect (col.6:

58-61). Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the aforementioned limitation into the method and system of Bobrow, as modified by Housman, in light of the teaching of Poor, in order to permit efficient retrieval of the images of gradable materials.

Response to Arguments

10. Applicant's arguments, see page 6, filed 8/23/06, with respect to rejections under **35 U.S.C. 112 second paragraph** have been fully considered and are persuasive. The 35 U.S.C. 112 second paragraph rejection has been withdrawn.

11. Applicant's arguments filed 8/23/06 in regards to rejections under **35 U.S.C. 103(a)** have been fully considered but they are not persuasive.

12. On pages 6-7, applicant argues that Poor's modification of Bobrow's teaching relies on hindsight. However, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

13. On pages 8-9, applicant argues, "For the teacher to place a grade on the paper before entry into the Bobrow et al scanning process is the antithesis of Bobrow's methodology, and it is entirely unreasonable to assert that such a flow would be obvious

in view of 8 q, Bobrow. Elimination of the scanning step is more than eliminating "a feature" of Bobrow et al. It is a total repudiation of the Bobrow et al system and would not be viewed as "obvious" given the intent and purpose of Bobrow et al."

14. In response to this argument, applicant should be respectfully reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings (as a whole) of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The cited prior arts are all under the same field of applicant's endeavor, "Interactive Educational System", therefore reliance on the teachings found in the prior arts are held valid (See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992)). Moreover, applicant should recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some **teaching**, suggestion, or motivation to do so found either in the references themselves or **in the knowledge generally available to one of ordinary skill in the art**. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as shown above, Bobrow teaches an Interactive Educational System that is capable of storing gradable material and graded material in an electronic format. However, even though Bobrow further includes the step of also electronically storing a version of the gradable material that has only the students marking on it, this only all the

more add to Bobrow's invention as suppose to nullify it as a reference and void all the teachings taught throughout the disclosure's embodiments.

Furthermore, applicant should respectfully note Altiris Inc. v. Symantec Corp., 318 F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003) wherein the court held that it was improper to read a specific order of steps into method claims where, as a matter of logic or grammar, the language of the method claims did not impose a specific order on the performance of the method steps, and the specification did not directly or implicitly require a particular order. Therefore, the applicant's interpretation as to a specific order in which the steps are performed requires the incorporation of limitations from the specification. However, incorporating the specifications limitations into the claims is improper. For the claims are only interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

15. On page 9, applicant further argues, "Authorities for the obviousness of omissions as set forth in MPEP § 2144.04 require that omission would be reasonable and not incompatible with the reference's teachings". In response, the examiner states that the omission is reasonable and compatible with the reference's teachings (as shown above). However, to further clarify, applicant should respectfully take into account that it is what is being taught as a whole that is being used as the basis for obviousness. The prior art teaches (among several other features) the ability to electronically store a student's graded material. This proves that this feature is well known in the art prior to applicant's invention. Therefore one of ordinary skill in the art

would have been motivated to use this feature in the environment disclosed above. For further clarification, applicant should respectfully note that another environment where this could be used is an environment where only the electronic storage of the graded material is necessary. The omission of the other features in this case is also reasonable and compatible with the reference teachings since the modified system would still fall under the scope of "Interactive Educational System".

16. All remaining arguments by applicant are reliant on the above addressed issue and hence each fall in kind.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Omotosho whose telephone number is (571) 272-3106. The examiner can normally be reached on m-f 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EO

Ronald Laneau
Primary Examiner
4/30/07